

## JC698 U.S. PTO



00909

01/18/02

**FOR DESIGN OR UTILITY APPLICATIONS**  
**(DO NOT USE FOR CIPs)**

**Rule 53(b)(1) PATENT APPLICATION:**

☐ Continuation )  
☒ Divisional ) application under 37 CFR 1.53(b)(1)  
 of pending prior application of

Group Art Unit: 3737

Inventor(s): Sullivan et al.

Examiner: Casler, B.

Parent Appln. No.:	08	934,176
	Series Code ↑	Serial No. ↑

Atty. Dkt. P 290530  
New M#

Client Ref

Parent Filed: September 19, 1997

This Appln. Filed: January 18, 2002

Title: METHOD AND APPARATUS USEFUL IN THE DIAGNOSIS OF OBSTRUCTIVE SLEEP APNEA OF A PATIENT (as Amended)

Hon. Commissioner of Patents  
Washington, DC 20231

Date: January 18, 2002

(Parent Matter No. 270907)

To effect the above-requested filing today:

1. **Attached** is a copy (which must be filed) of the prior application, including:

## □ Abstract

☒ Specification and claims (38 pages) (must be attached)

☒ Drawings (must be attached if originally filed): 11 sheet(s)/set: ☐ 1 set informal:

☒ Formal of size

☒ A4

□ 11"

**1A** Always X one box, only:

☒ Copy of Signed declaration or oath as originally filed in prior application attached

(2) ☐ NO declaration or fee is enclosed; therefore, this is a filing under Rule 53(f).

2. ☐ This application is hereby filed by less than all of the inventors named in the prior application. Petition is hereby made requesting deletion as inventor(s) of the following who is/are **not** inventor(s) of the invention being claimed in this application (DELETE THE FOLLOWING INVENTOR(S)):

1. \_\_\_\_\_
3. \_\_\_\_\_
5. \_\_\_\_\_
7. \_\_\_\_\_

2. \_\_\_\_\_  
4. \_\_\_\_\_  
6. \_\_\_\_\_  
8. \_\_\_\_\_

2.5 THE INVENTOR(S) FOR THIS NEW APPLICATION IS(ARE):

1. \_\_\_\_\_
3. \_\_\_\_\_
5. \_\_\_\_\_
7. \_\_\_\_\_

2. \_\_\_\_\_  
4. \_\_\_\_\_  
6. \_\_\_\_\_  
8. \_\_\_\_\_

3. The entire disclosure of the prior application is considered as being part of the disclosure of the accompanying application and is hereby incorporated therein by reference thereto.

4. ☒ Priority is claimed under 35 U.S.C. 119/365 based on filing in Australia of \_\_\_\_\_ (country)
- |     | Application No. | Filing Date   |     | Application No. | Filing Date   |
|-----|-----------------|---------------|-----|-----------------|---------------|
| (1) | PI 2730         | June 26, 1987 | (2) | PI 4234         | Sept. 8, 1987 |
| (3) | _____           | _____         | (4) | _____           | _____         |
| (5) | _____           | _____         | (6) | _____           | _____         |

a. ☐ \_\_\_\_\_ (No.) Certified copy/copies attached.

b. ☐ Certified copy/copies previously filed on \_\_\_\_\_ in \_\_\_\_\_  
U.S. Application No. \_\_\_\_\_ / \_\_\_\_\_, filed on \_\_\_\_\_  
series code  $\uparrow$  \_\_\_\_\_  $\uparrow$  serial no. \_\_\_\_\_

c. ☐ Certified copy/copies filed during International stage of PCT/ \_\_\_\_\_ / \_\_\_\_\_

- 4(a). (a) ☒ Domestic priority is claimed from PCT/ AU88/00215, filed June 27, 1988.  
(b) ☐ Benefit is claimed of Provisional Application No. 60/ \_\_\_\_\_, filed \_\_\_\_\_.

5. ☐ Assignee (optional) \_\_\_\_\_

6. ☒ Attached is the following number of Assignments (including original and all later successive ones by different assignors): 1 and respective new Cover Sheets. (Do **NOT** file old cover sheets.)

(Assignments in parent must be refiled with new Cover Sheets in this continuing application if you want it/them recorded against the continuing application.)

Please return the recorded Assignment to the undersigned.

7. ☒ The power of attorney in the prior application is to Glenn J. Perry, Reg. no. 28458

(Name and Reg. No.)

whose current address is as in item 8 below.

a. ☒ Recognize as associate attorney Paul T. Bowen, Reg. No. 38009 whose current address is as in item 8 below

(Name, Reg. No. and Address)

8. **Address all future communications to Intellectual Property Group of Pillsbury Winthrop LLP, 1600 Tysons Boulevard, McLean, VA 22102**

9. This application claims benefit of the following prior US application(s), the contents of which are incorporated into this application by this reference:

No. <u>08/</u>	<u>934,176</u>	filed	<u>09/19/1997</u>
No. <u>08/</u>	<u>838,462</u>	filed	<u>04/07/1997</u>
No. <u>08/</u>	<u>654,742</u>	filed	<u>05/29/1996</u>
No. <u>08/</u>	<u>385,742</u>	filed	<u>02/08/1995</u>
No. <u>08/</u>	<u>100,556</u>	filed	<u>07/30/1993</u>
No. <u>07/</u>	<u>892,692</u>	filed	<u>05/27/1992</u>
No. <u>07/</u>	<u>548,108</u>	filed	<u>07/05/1990</u>
No. <u>07/</u>	<u>457,757</u>	filed	<u>12/21/1989</u>

No. PCT/ \_\_\_\_\_ / \_\_\_\_\_ filed \_\_\_\_\_, which

designated the U.S. and that International Application ☐ was ☐ was not published under PCT Article 21(2) in English

- 9(a). ☒ See the attached Preliminary Amendment, which amends the first page of the specification to claim benefit of the above listed US application(s)

10. **Small Entity Status**  $\rightarrow$  ☒ is Not claimed ☐ is claimed (pre-filing confirmation required)

(No.) Small Entity Statement(s) (not essential since 9/8/00) were/are:

☐ filed in above prior application

☐ attached.

11. Petition to extend the life of the above prior application to at least the date hereof  
 (one box) ☐ is being concurrently filed in that prior application (Use Form PAT-111).  
 (must be) ☐ was previously filed in that prior application (Check length of prior extension).  
 (X'd) ☒ is not necessary for copendency (**Double check** before X'ing this box).
12. ☒ **INFORMATION DISCLOSURE STATEMENT:** Attached is Form PTO-1449 listing all of the documents cited by Applicant and the PTO in the parent application(s) relied upon under 35 USC 120 and referenced in item 9 above. Per Rule 98(d) copies of those documents are not required now. Please consider those documents and advise that they have been considered in this new application as by returning a copy of the enclosed Form PTO-1449 with the Examiner's initials in the left column per MPEP 609. .
13. ☐ Attached is a Rule 103(a) Petition to Suspend Action.
14. ☒ **Please see** the attached Preliminary Amendment which reduces the number of claims for purposes of reducing the initial filing fee.

2-24

**FILING FEE**

THE FOLLOWING FILING FEE IS BASED ON

-&gt;-&gt;-&gt;-&gt; CLAIMS AS FILED AND CHANGED BY PRELIMINARY AMENDMENT IN ITEM 14 &lt;-&lt;-&lt;-&lt;-

**NOTE:** If box 1A2 is X'd, do not pay fees,  
 but leave lines 15-22 and 27-32 blank.

				Large/Small Entity		Fee Code	
15.	Basic Filing Fee	.....	Design Application	\$330/\$165		106/26	
16.	Basic Filing Fee	.....	Utility Application	\$740/\$370	+740	101/201	
17.	Total Effective Claims	1	minus 20 =	0	x \$18/\$9	+0	103/203
18.	Independent Claims	1	minus 3 =	0	x \$84/\$42	+0	102/202
19.	If any proper multiple dependent claim (ignore improper) is present,			\$280/\$140	+0	104/204	
20.				<b>Subtotal =</b>	<b>\$740</b>		
21.	If "petition" box 13 above is X'd, add petition fee. ....			\$130	+0	122	
21A.	If box 6 above is X'd, add Assignment recording fee ....			\$ 40	+40	581	
22.				<b>TOTAL FILING FEE ATTACHED =</b>	<b>\$780</b>		

(carry forward to Item 31)

23. ☒ **ATTACHED:** Associate Power of Attorney, Revocation of Prior Powers, Transmittal Letter and (10) sheets of formal drawings
24. ☒ See the attached Preliminary Amendment
25. ☐ See NONPUBLICATION REQUEST under Rule 213(a) attached (Pat-258)

26.

**ADDITIONAL FEE CALCULATION FOR  
PRELIMINARY AMENDMENT  
PER BOXES 24/25**

	Claims remaining after amendment	Highest number previously paid for	Present Extra	Additional Fee	
					Large/Small Entity File Code
27.	Total Effective Claims	*47	minus ** 20 = 27	x \$18/\$9 = \$ 486	(103/203)
28.	Independent Claims	*9	minus *** 3 = 6	x \$84/\$42 = + 504	(102/202)
29.	If amendment enters proper multiple dependent claim(s) into this application for the first time, add (per application) .....\$280/\$140				+ 0 (104/204)
30.	ADDITIONAL FEE				\$ 990
31.	plus FEE from item 22 on page 3				+ 780
32.	<b>TOTAL FEE ATTACHED</b>				<b>\$ 1770</b>

33. \*If the entry in this space is less than a entry in the next space, the "Present Extra" result is "0"

34. \*\*If the "Highest number previously paid for" (see item 17 above) is less than 20, write "20" in this space

35. If the "Highest number previously paid for" (see item 18 above) is less than 3, write "3" in this space



00909

Our Deposit Account No. 03-3975

Our Order No. 74066

290530

C#

M#

**CHARGE STATEMENT:** Upon the filing of a Declaration pursuant to Rule 60(b) or 60(d), the Commissioner is hereby authorized to charge any fee specifically authorized hereafter, or any missing or insufficient fee(s) filed, or asserted to be filed, or which should have been filed herewith or concerning any paper filed hereafter, and which may be required under Rules 16-18 (missing or insufficient fee only) now or hereafter relative to this application and the resulting Official document under Rule 20, or credit any overpayment, to our Account/Order Nos. shown above for which purpose a duplicate copy of this sheet is attached.

**This CHARGE STATEMENT does not authorize charge of the issue fee until/unless an issue fee transmittal form is filed.**

**Pillsbury Winthrop LLP  
Intellectual Property Group**

By Atty: Paul T. Bowen

Reg. No. 38009

Sig:

Fax: (703) 905-2500

Tel: (703) 905-2020

Atty./Sec PTB/dlh

**NOTE No. 1:** File this Request in duplicate with 2 postcard receipts (PAT-103) & attachments

**NOTE No. 2:** Is extension in parent necessary for copendency? **DOUBLE CHECK** Item 11 above.

If yes, printout Pat-111 and head it in parent.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re PATENT APPLICATION OF

Confirmation No.: Unknown

Sullivan et al.

Group Art Unit: 3737

Appln. No.: Div. of Appln. No. 09/934,176 Examiner: Casler, B.

Filed: January 18, 2002

Title: METHOD AND APPARATUS USEFUL IN THE DIAGNOSIS OF OBSTRUCTIVE  
SLEEP APNEA OF A PATIENT (as amended)

January 18, 2002

\* \* \* \* \*

**TRANSMITTAL OF FORMAL DRAWINGS**


Hon. Commissioner of Patents  
Washington, D.C. 20231

Sir:

Attached are (10) ten sheets of formal drawings to be made of record in the  
above-identified application.

Respectfully submitted,

Pillsbury Winthrop LLP

By:   
Paul T. Bowen  
Reg. No.: 38009  
Tel. No.: (703) 905-2020  
Fax No.: (703) 905-2500

PTB\dlh  
1600 Tysons Boulevard  
McLean, VA 22102

(703) 905-2000

Enclosure: (10) sheets of formal drawings